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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/973,664
Filing Date: October 09, 2001
Appellant(s): ACKERMAN ET AL.

Joseph P. Mehrle
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/14/08 appealing from the Office action mailed 12/13/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

The present application includes claims15 – 21, all of which stand rejected.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0107809	Biddle et al.	8-2002
7,203,703	Clement	4-2007

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

Claims 15-21 have been examined.

P = paragraph, e.g. p1 – paragraph 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biddle et al. USPAP 2002/0107809, and further in view of Clement et al. USP 7,203,703.

As per claim 15, Biddle discloses a method for licensing external processes on a server comprising the steps of: generating an electronic license, wherein the electronic license is generated by formatting a customer order for a software product in accordance with a licensing schema and the formatted electronic license to include a plurality of software command directives embedded within the formatted electronic license to indicate whether a particular software command directive associated with a particular feature of the soft-ware product is to be accepted for registration or rejected for registration, and wherein each software command directive includes a command name associated with a particular software command or operation of the software

product and indicating the acceptance or rejection of registration for that particular software command or operation within the software product and executing the registered commands (abstract; p18, 72, 14 and 17; claims 19, 27-28, 35-37). Although the user of inclusion and exclusion identifiers is inherent and well known in the art, a second reference is brought in to show this limitation. Biddle does not disclose an inclusion and/or exclusion identifier. Clement discloses an inclusion or exclusion identifier, and wherein at least one software command for the software product is associated with the exclusion identifier; and registering selective ones of the software commands in response to the software command directives and their inclusion and exclusion identifiers (col.9, 50-54). It would have been obvious to modify Biddle to include an inclusion and/or exclusion identifier as taught by Clement in order to give the user and/or vendor the ability to modify the software license such that it is cost beneficial for both the user and the vendor as to what part of the software is to be used.

As per claim 16, Biddle further discloses wherein the step of includes directing the software product to only use a set of licensed hardware resources, the set of licensed hardware resources also being defined by one or more fields in the electronic license (abstract; p18, 72, 14 and 17; claims 19, 27-28, 35-37).

As per claim 17, Biddle further discloses wherein the step of generating includes generating a license upgrade, the license upgrade defining a set of additional commands for registration that are not part of software commands registered in conjunction with one or more prior licenses (abstract; p18, 72, 14 and 17; claims 19, 27-28, 35-37).

As per claim 18, Biddle further discloses wherein the step of generating includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the software product that are not part of hardware resources licensed for use by prior licenses (abstract; p18, 72, 14 and 17; claims 19, 27-28, 35-37).

As per claim 19, Biddle further discloses wherein the step of generating includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the software product that add further capabilities to hardware resources licensed for use by prior licenses (abstract; p18, 72, 14 and 17; claims 19, 27-28, 35-37).

As per claim 20, Biddle further discloses further comprising either one of (a) installing the electronic license in the server prior to shipment of the server to an end-user of the server and (b) providing the electronic license to the end-user on a removable media for installation in the server after the shipment of the server to the end-user (abstract; p18, 72, 14 and 17; claims 19, 27-28, 35-37).

As per claim 21, Biddle further discloses further comprising installing the electronic license in the server in a over-the-wire process including (a) digitally signing the electronic license by a vendor, (b) transmitting the digitally signed electronic license over a communications network from the vendor to the server, (c) validating the digitally signed electronic license by the server and (d) installing the validated electronic license in the server (abstract; p18, 72, 14 and 17; claims 19, 27-28, 35-37).

(10) Response to Argument

The 35 U.S.C. § 112 second paragraph has been withdrawn.

The 35 U.S.C § 103(a) argument:

The appellant argues that " *The Examiner has never provided any reference in support of his contention that exclusion identifiers were well known in the art as of the file date of this application."* Examiner respectfully disagrees. An exclusion identifier is well known in the art of computer science/programming/software development. This is a well know fact and can be found in any standard text for programming classes. For example, the college text, "Java, how to program" by H.M. Deitel and P.J. Deitel includes exclusion identifiers and it can be found in their fifth edition, on page 195. An exclusion identifier in software commands or programming is very well know and has been taught in computer science texts since programs have been written for computers, which goes back decades. Nevertheless, the second reference, Clements et al., USP 7,203,703 discloses "inclusion or exclusion of specific data strings, or by a unique procedure identifier….." col.9, lines 50-54.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Behrang Badii; /BB/

Conferees:

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694

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